

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

NATERA, INC.,

Plaintiff,

v.

ARCHERDX, INC., ARCHERDX, LLC,
AND INVITAE CORPORATION

Defendants.

C.A. No. 20-cv-125-LPS
(Consolidated)

REDACTED - PUBLIC VERSION

**TJUH'S RESPONSE TO PLAINTIFF'S JUNE 15, 2021
DISCOVERY DISPUTE LETTER**

Dated: June 16, 2021

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Attorneys for TJUH

Dear Chief Judge Stark,

Third party Thomas Jefferson University Hospital (“TJUH”) writes in response to Natera Inc.’s (“Natera”) June 15 letter seeking to compel a deposition of one of TJUH’s laboratory testing staff members.

Natera’s demand for a deposition of TJUH is disproportionate to the needs of the case and unjustified. [REDACTED]

[REDACTED] At the same time, TJUH is a non-profit hospital with stretched resources as the country emerges from a pandemic.

Nevertheless, Natera has subpoenaed TJUH for documents, ostensibly to show third-party use for the purpose of proving inducement. In response to Natera’s subpoena, [REDACTED]

[REDACTED] This is all that Natera needs.

Natera nonetheless insists upon burdening TJUH and deposing one of its laboratory staff members, whose time spent providing medical services is undoubtedly far more critical than Natera’s thirst for discovery. A “party seeking discovery from a third party is required to show the relevance *and need* of the discovery sought.” *Avago Techs. U.S., Inc v. IPtronics Inc.*, 309 F.R.D. 294, 299 (E.D. Pa. 2015) (emphasis added). “In assessing the burden of complying with a subpoena, a court may consider as one factor that a deponent is not a party.” *Truswal Sys. Corp. v. Hydro-Air Eng'g, Inc.*, 813 F.2d 1207, 1210 (Fed. Cir. 1987).

Natera offers no justification for imposing the burden of a deposition upon TJUH. As to the element of burden, Natera has asserted in this case that “[d]epositions under oath remain a significant undertaking for witnesses and counsel apart from travel and lodging.” D.I. 142 at 3. Natera thus cannot deny that the burden of a deposition would be significant, particularly for a third party witness engaged in important medical work, who will need to take time from this work to both prepare for and sit for the deposition. This consideration decidedly weighs against a deposition. *See id.*

As to the required need element, Natera has steadfastly refused to explain in meet and confer why a TJUH deposition is needed. *See* Ex. 4. In its letter, Natera does no better. Natera does not even assert need. D.I. 255 at 3. Natera simply asserts that the requested discovery is “relevant to Natera’s indirect infringement and damage claims against Defendants.” *Id.* Merely asserting relevance, however, is not enough. *See Avago*, 309 F.R.D. at 299. Natera does not identify any information that is uniquely in the hands of TJUH that it has not received from ArcherDX or that may be additive after meaningful opportunities to query ArcherDX and review the extensive internal documents already provided by TJUH to Natera. Natera knows how much

TJUH has bought, it has the details of the products, and it has ArcherDX's communications regarding the products. Natera will likely get dozens of hours of deposition from ArcherDX witnesses regarding these products. Nothing else is needed.¹

In fact, Natera has acknowledged that a TJUH deposition is unnecessary because it has already offered to accept a declaration from TJUH in lieu of a deposition. *See* Ex. 4. Given the weak showing in Natera's letter, TJUH probably should not even be required to prepare this declaration. If Natera is given any further discovery, it should be directed to accept this declaration, together with all the materials produced in response to its subpoena, as sufficient. In no circumstances is an intrusive deposition warranted.

Respectfully submitted,

/s/ Brian E. Farnan

Brian E. Farnan

cc: Counsel of Record (Via E-Mail)

¹ Natera's letter suggests that a TJUH in-house attorney with first interfaced with Natera previously agreed to a deposition. The cited correspondence, however, is hardly clear on this point and is simply focused on extension of response deadlines. D.I. 225, Ex. 5. Regardless, Natera does not contend that TJUH has waived any right to object to a burdensome deposition.

EXHIBIT 1

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EXHIBIT 2

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IN ITS

ENTIRETY

EXHIBIT 3

REDACTED

IN ITS

ENTIRETY

EXHIBIT 4

From: Walter, Derek
Sent: Monday, June 7, 2021 10:27 PM
To: Benassi, Jodi; ArcherDX Natera; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: Natera-ArcherDX MWE Team; dfahnestock; JBlumenfeld@MNAT.com; Raucci, Anthony D.
Subject: RE: Subpoena to Genosity

Jodi:

TJUH objects to the deposition at least on the basis we explained during our meet and confer. It's totally unnecessary for this case and disproportionate to the needs of the case for Natera to seek to depose a witness from a non-profit hospital that is a minor customer of Invitae. We disagree that you have not received substantial information. To the extent you need further clarification regarding the details of certain spreadsheets, such information can easily be provided via a declaration without forcing a hospital laboratory staff member to take time out of his or her work day to prepare for and sit for deposition. We've asked many times why such intrusive discovery from this third party is justified, and you've never explained it. Suggesting that you may force a witness from TJUH to actually attend trial is unjustified.

A declaration should be enough here.

Thanks,

Derek

From: Benassi, Jodi <Jbenassi@mwe.com>
Sent: Friday, June 4, 2021 4:14 PM
To: Walter, Derek <Derek.Walter@weil.com>; ArcherDX Natera <ArcherDX.Natera@weil.com>; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; dfahnestock <dfahnestock@morrisnichols.com>; JBlumenfeld@MNAT.com; Raucci, Anthony D. <araucci@MNAT.com>
Subject: RE: Subpoena to Genosity

Derek,

First, Natera did not agree to a written declaration in lieu of a TJU deposition, we said we would consider it as an option. Natera will not accept a written declaration on the condition that it waive objections or not call TJU as a witness at the trial. Second, TJU has not provided substantial information, it has provided less than Natera requested and we pointed out Defendants deficiencies in a separate communication. As we've explained in prior correspondences and during our meet and confer, we believe a focused deposition is most efficient for all parties involved (rather than a written declaration) and we do not expect a full day deposition.

On what grounds is TJU objecting to a deposition at this point? TJU has already agreed to a deposition, as I pointed out in my earlier email. This is a large hospital with almost 10,000 employees and is one of Archer's top 30 customers.

Regards,
Jodi

JODI BENASSI
Associate

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Tel +1 628 218 3896 **Mobile** +1 408 202 6601 **Email** jbenassi@mwe.com
Biography | **Website** | **vCard** | **Twitter** | **LinkedIn**

From: Walter, Derek <Derek.Walter@weil.com>

Sent: Thursday, June 3, 2021 8:26 PM

To: Benassi, Jodi <jbenassi@mwe.com>; ArcherDX.Natera@weil.com; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com

Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; dfahnestock <dfahnestock@morrisnichols.com>; jblumenfeld@mnat.com; Raucci, Anthony D. <araucci@MNAT.com>

Subject: RE: Subpoena to Genosity

[External Email]
[External Email]

Jodi:

We've conferred with TJUH, and we do not believe a deposition is warranted here. As you suggested during our meet and confer, in lieu of a deposition, we'll work with you to prepare an appropriate declaration regarding the substance of the spreadsheets TJUH has been produced on the condition you'll agree not to attempt to call a TJUH witness at trial in the event this case proceeds to trial. Given that we've provided substantial information regarding the documents at issue, we expect Natera will prepare the first draft of the declaration for our review.

Thanks,

Derek

From: Benassi, Jodi <jbenassi@mwe.com>

Sent: Thursday, May 27, 2021 1:31 PM

To: ArcherDX Natera <ArcherDX.Natera@weil.com>; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com

Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; dfahnestock <dfahnestock@morrisnichols.com>; JBlumenfeld@MNAT.com; Raucci, Anthony D. <araucci@MNAT.com>

Subject: RE: Subpoena to Genosity

Counsel,

We are concerned with Genosity's continued delay in providing the information it agreed to produce more than three months ago. We want to be reasonable and appreciate that Weil became counsel of record on April 26, but we informed you of Natera's pending request over a month ago and this request seeks information in Genosity's possession and maintained in the ordinary course of business. We need confirmation by COB tomorrow that no later than June 3 – Genosity will produce this information. As you know, the close of fact discovery is fast approaching. If we do not receive confirmation, we will have no choice but to seek the Court's assistance.

Regards,
Jodi

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From: Paulson, Kaitlin <Kaitlin.Paulson@weil.com>
Sent: Monday, May 24, 2021 5:07 PM
To: Benassi, Jodi <jbenassi@mwe.com>; Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; dfahnestock <dfahnestock@morrisnichols.com>; jblumenfeld@mnat.com; Raucci, Anthony D. <araucci@MNAT.com>
Cc: ArcherDX.Natera@weil.com; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Subject: RE: Subpoena to Genosity

[External Email]

Counsel:

We received your email. As you are aware, we only recently became counsel of record in this matter and are diligently endeavoring to get up to speed. Currently, Genosity is preparing the spreadsheet responsive to RFP No. 5 and we will provide it to you when it is complete.

Regards,
Kaitlin

From: Benassi, Jodi <jbenassi@mwe.com>
Sent: Monday, May 24, 2021 6:06 AM
To: ArcherDX Natera <ArcherDX.Natera@weil.com>; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; dfahnestock <dfahnestock@morrisnichols.com>; jblumenfeld@MNAT.com; Raucci, Anthony D. <araucci@MNAT.com>
Subject: RE: Subpoena to Genosity

Counsel,

Please let us know your availability to meet and confer by COB today.

Regards,
Jodi

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Biography | **Website** | **vCard** | **Twitter** | **LinkedIn**

From: Benassi, Jodi
Sent: Wednesday, May 19, 2021 6:21 PM
To: ArcherDX.Natera@weil.com; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; Fahnestock, Derek <dfahnestock@morrisnichols.com>; jblumenfeld@mnat.com; Raucci, Anthony D. <araucci@MNAT.com>
Subject: RE: Subpoena to Genosity

Counsel,

Archer has had ample time to investigate and respond to this request and close of fact discovery is fast approaching.

Please let us know your availability to meet and confer as it appears the parties are at an impasse on this issue.

Regards,
Jodi

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Biography | **Website** | **vCard** | **Twitter** | **LinkedIn**

From: Reines, Edward <edward.reines@weil.com>
Sent: Friday, April 30, 2021 3:31 PM
To: Benassi, Jodi <jbenassi@mwe.com>; ArcherDX.Natera@weil.com; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; Fahnestock, Derek <dfahnestock@morrisnichols.com>; jblumenfeld@mnat.com; Raucci, Anthony D. <araucci@MNAT.com>
Subject: RE: Subpoena to Genosity

[External Email]

Jodi, thanks for your note. Yes, we are taking over the representation as I discussed with Bill earlier this week. We will get our arms around the below issues and expect to respond shortly. A good weekend to all. Best, Ed

From: Benassi, Jodi <jbenassi@mwe.com>
Sent: Friday, April 30, 2021 3:21 PM
To: ArcherDX Natera <ArcherDX.Natera@weil.com>; bfarnan@farnanlaw.com; mfarnan@farnanlaw.com
Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; Fahnestock, Derek <dfahnestock@morrisnichols.com>; jblumenfeld@MNAT.com; Raucci, Anthony D. <araucci@MNAT.com>
Subject: RE: Subpoena to Genosity

Counsel,

We have not received a response to this email.

Please advise.

Regards,
Jodi

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Biography | **Website** | **vCard** | **Twitter** | **LinkedIn**

From: Benassi, Jodi
Sent: Thursday, April 22, 2021 4:47 PM
To: ArcherDX.Natera@weil.com; bfarnan@farnanlaw.com; 'mfarnan@farnanlaw.com' <mfarnan@farnanlaw.com>
Cc: Natera-ArcherDX MWE Team <Natera-ArcherDXMWETeam@mwe.com>; Fahnestock, Derek <dfahnestock@morrisnichols.com>; jblumenfeld@mnat.com; Raucci, Anthony D. <araucci@MNAT.com>
Subject: Subpoena to Genosity

Counsel,

As you know, Genosity was recently purchased by Invitae and as such we understand that you will be taking over representation of Genosity in response to the subpoena issued by Natera. On Feb. 25, 2021, Genosity agreed to produce a spreadsheet or documents sufficient to show the number of times Genosity has performed the steps and/or process with the Accused Products, including the identity of primers, target loci, molecular barcodes, and PCR conditions in response to Natera's subpoena request no. 5. We still have not received these documents. Please confirm Genosity will produce responsive documents by April 30, 2021 or let us know when we can expect to receive these documents.

On Feb. 25, 2021, Genosity also stated that it conferred with Archer and Archer has confirmed it will be producing documents responsive to subpoena Request Nos. 1, 2, and 4. Natera has not received responsive documents from Archer. As counsel for Archer (and Genosity), and pursuant to the parties' joint status report [D.I. 175], please confirm Archer will produce responsive documents by April 30, 2021.

Regards,
Jodi

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EXHIBIT 5

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IN ITS

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